

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/487,239

**REMARKS**

Claims 2, 3 and 5-11 are all the claims pending in the application. Applicants thank the Examiner for allowing claims 6 and 8-11. Claims 2, 3, 5 and 7 presently stand rejected.

Claims 2, 3, 5 and 7 are objected to because of informalities. Applicants correct the spelling error to overcome this informality.

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka et al. (5,772,884) in view of Herding et al. (5,547,481).

Claims 5 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka et al. (5,772,884) in view of Herding et al. (5,547,481) as applied to claim 3, and further in view of Dauber et al. (5,916,671).

**Analysis**

Of the rejected claims, only claim 3 is in independent form; therefore, the following discussion is initially directed to this independent claim.

Claim 3 is directed to a laminate for forming an enclosed space to hold an adsorbent. The Examiner states that the language directed to the enclosed space is an “intended-use limitation” and not a structural limitation. Moreover, the Examiner states that the enclosed space is not a part of the claims, and thus, the position of the film within the space is not limiting.

Applicants respectfully submit that a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. The functional limitation recited in claim 1 (i.e., for forming an enclosed space to hold an adsorbent), defines a particular

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capability or purpose that is served by the recited element (i.e., the laminate), sets definite boundaries on the patent protection sought, and serves to precisely define the present structural attributes of the interrelated component parts of the claimed assembly. See MPEP §2173.05(g).

Since all limitations must be considered in considering obviousness within 35 U.S.C. § 103, it is improper to ignore specific limitations distinguishing over references. *In re Boe*, 505 F.2d 1297, 184 USPQ 38 (CCPA 1974). Thus, when evaluating the laminate, the Examiner should not ignore the specific functional limitation that the laminate forms an enclosed space to hold an adsorbent.

With respect to the Examiner's statement that the "enclosed space is not part of the claims" and the position of the film within the enclosed space "is not found to be limiting in any patentable sense", Applicants respectfully submit that the claim preamble should be read in context of the entire claim, and should be given patentable weight if it is necessary to give life, meaning and vitality to the claim. See MPEP § 2111.02.

In claim 3, the enclosed space is first recited at the beginning of the claim, to further limit the laminate element. Later, the enclosed space is referred back to in the body of the claim, in context with the position of the film within the laminate. Thus, the enclosed space limits the structure of the claimed invention and thus, must be treated as a claim limitation.

In view of the foregoing, the features directed to the enclosed space and the position of the film within the enclosed space, as set forth in claim 3, should be considered when evaluating the patentability of the claims. In particular, the UHPE film is adhered to the side of the PTFE film facing the interior of the enclosed space formed by the laminate. Since none of the cited

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prior art is directed to this structure, the combination of the cited references fails to render claim 3 obvious, as discussed in the Response filed by Applicants on October 7, 2002.

The remaining rejections are directed to the dependent claims. These claims are patentable for at least the same reasons as claim 3, by virtue of their dependency therefrom.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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